

### **REMARKS/ARGUMENTS**

In the Office Action mailed February 4, 2009 (hereinafter, "Office Action"), claims 1-4, 8, 9, 11-14, 18, 19, 21-23, 27 and 28 stand rejected under 35 U.S.C. § 103. Claims 1, 12, and 21 have been amended. Claims 30-32 have been added.

Applicants respectfully respond to the Office Action.

#### **I. Claims 1-4, 8, 9, 11-14, 18, 19, 21-23, 27 and 28 Rejected Under 35 U.S.C. § 103**

Claims 1-4, 8, 9, 11-14, 18, 19, 21-23, 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,142,318 to Lopez et al. (hereinafter, "Lopez") in view of U.S. Patent No. 7,173,724 to Nomura et al. (hereinafter, "Nomura"). Applicants respectfully traverse.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 2007 U.S. LEXIS 4745, at \*\*4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)). Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at \*\*37. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the subject matter in these claims.

Claim 1 has been amended to recite "wherein the proof sheet comprises at least one compressed form of a page in the scanned documents." This amendment is supported by at least

page 6, lines 15-19 of Applicants' specification. Lopez, alone or in combination with Nomura, does not teach or suggest this claimed subject matter.

Instead, Lopez teaches a "printing system" that "enables digital images associated with Internet web pages to be previewed, selected, and printed without the need for a computer attached to the printer." (Lopez, col. 3, lines 40-44). Specifically, Lopez teaches "automatically analyz[ing] the web page to identify the image files associated with the page" and "print[ing] a proof sheet for at least some of the image files." (Lopez, col. 2, lines 27-29 and 33-35). Then, the "marked proof sheet is scanned so as to determine marked selection areas, and the image files associated with the marked selection areas are printed." (Lopez, col. 2, lines 37-39). The "proof sheet" in Lopez includes "thumbnail images" and "user designation areas." The "user can fill in one or more bubbles 56 in the user designation area B adjacent a particular thumbnail image I to 'order' the desired number and size of final prints of that digitally stored image." (Lopez, col. 6, lines 38-41). These "thumbnail images" are "printed graphical representations of reduced size and/or quality" of the "digitally stored images." (See Lopez, col. 6, lines 3-5). This does not teach or suggest that "the proof sheet comprises at least one compressed form of a page in the scanned documents."

As best understood, the Office Action interprets either the "proof sheet" or the printed images in Lopez as the "proof sheet" in claim 1. (Office Action, page 5). However, neither interpretation "comprises at least one compressed form of a page in the scanned documents." If the "proof sheet" in Lopez is interpreted as the "proof sheet" in claim 1, the "thumbnail images" on the "proof sheet" in Lopez are "graphical representations" of "digitally stored images," not "scanned documents." Specifically, the "digital image files" in Lopez come from either a "web page" or from a "digital camera." (See Lopez, col. 4, lines 4-15). In contrast, claim 1 requires that the "proof sheet" comprises "at least one compressed form of a page in the scanned documents" that were used to "produce the scan job." At most, then, Lopez teaches a "proof sheet" with "thumbnails" based on digital files, not "scanned documents." On the other hand, if the printed images in Lopez are interpreted as the "proof sheet" in claim 1 with the scanned "proof sheet" as the "scanned documents," then the printed images do not comprise a "compressed form" of the "proof sheet." The

printed images are in a “final, higher quality form” than the “thumbnails” on the “proof sheet” in Lopez, not a “compressed form.” In contrast, claim 1 requires that the “proof sheet” comprises “at least one compressed form of a page in the scanned documents.” Furthermore, the printed images in Lopez do not include the non-image information included in the “proof sheet” such as the “user designation area,” so the printed images are not “a compressed form of a *page*,” only of the image portion of a page. Neither the “proof sheet” nor the printed images in Lopez can reasonably be construed as the “proof sheet” in claim 1. Therefore, Lopez does not teach or suggest this claimed subject matter.

Likewise, Nomura does not teach or suggest this claimed subject matter. Instead, Nomura teaches “an image forming system provided, in combination, with (a) a scanner for optically reading a document image and (b) a printer for forming an image on a recording medium, where the scanner and the printer are respectively capable of being used individually.” (Nomura, col. 1, lines 7-11). There is no mention of a “proof sheet,” especially one that “comprises at least one compressed form of a page in the scanned documents.” Therefore, Nomura does not teach or suggest this claimed subject matter.

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn because Lopez, alone or in combination with Nomura, does not teach or suggest all of the subject matter of claim 1.

Claims 2-4, 8, 9 and 11 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 2-4, 8, 9 and 11 be withdrawn.

Claim 12 is being amended to recite “wherein the proof sheet comprises at least one compressed form of a page in the scanned documents.” As discussed above, Lopez in view of Nomura does not teach or suggest this claimed subject matter. Accordingly, Applicants respectfully submit that claim 12 is allowable. Claims 13-14, and 18-19 depend from claim 12, and are therefore allowable for at least the same reasons.

Claim 21 is being amended to recite “wherein the proof sheet comprises at least one compressed form of a page in the scanned documents.” As discussed above, Lopez in view of Nomura does not teach or suggest this claimed subject matter. Accordingly, Applicants respectfully submit that claim 21 is allowable. Claims 22-23 and 27-28 depend from claim 21, and are therefore allowable for at least the same reasons.

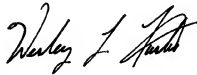
## **II. New Claims 30-32**

Claims 30-32 have been added. Applicants submit that claims 30-32 are fully supported by Applicants' specification. Specifically, claim 30 is supported by at least page 6, lines 8-15 of Applicants' specification. Claim 31 is supported by at least page 6, lines 20-22 of Applicants' specification. Claim 32 is supported by at least page 7, lines 3-6 of Applicants' specification. Claims 30-32 depend directly from claim 1. As such, Applicants submit that claims 30-32 are patentable for at least the same reasons as those previously described.

**III. Conclusion**

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Wesley L. Austin', written in a cursive style.

/Wesley L. Austin/

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Date: May 4, 2009

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